



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/604,082	06/27/2000	Steven M. Besette	45112-089	4329

23117 7590 08/18/2005

NIXON & VANDERHYE, PC
901 NORTH GLEBE ROAD, 11TH FLOOR
ARLINGTON, VA 22203

EXAMINER

AFREMOVA, VERA

ART UNIT	PAPER NUMBER
----------	--------------

1651

DATE MAILED: 08/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/604,082

Applicant(s)

BESSETTE ET AL.

Examiner

Vera Afremova

Art Unit

1651

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 July 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4, 19 and 45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4, 19 and 25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/15/2005 has been entered.

Claims 4, 19 and 45 as amended (7/05/2005) are pending and under examination.

Claim Rejections - 35 USC § 112

New matter

Claims 4 and 19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Insertion of the limitation "pesticidally active ingredient consisting of rosemary oil and phenethyl propionate" in claim 4 and insertion of the limitation "pesticidally active ingredient consisting of rosemary oil, peppermint oil and phenethyl propionate" in claim 19 have no support in the as-filed specification. The insertion of this limitation is a new concept because it neither has literal support in the as-filed specification by way of generic disclosure, nor are there specific examples of the newly limited genus that would show possession of the concept of the

Art Unit: 1651

use of “pesticidally active ingredient” that is limited to 2 or 3 components as in the method of claim 4 or in the method of claim 19 respectively.

The generic disclosure about the use of compositions comprising “pesticidally active ingredient consisting of rosemary oil and phenethyl propionate” or “pesticidally active ingredient consisting of rosemary oil, peppermint oil and phenethyl propionate” is absent.

The study A examples (specification pages 9-11) indicates that rosemary oil, peppermint oil and phenethyl propionate are active ingredients (page 9, line 13) as related to their pesticidal effects demonstrated by K/D (knockdown and mortality) testing (page 10) on insects such as cockroaches. The study A pesticidal mixtures EN1 through EN8 consist from 1 to 5 active components (pages 9-10) wherein the presently claimed combination “consisting of rosemary oil and phenethyl propionate” and the presently claimed combination “consisting of rosemary oil, peppermint oil and phenethyl propionate” are not described. The study B through the study E examples (pages 11-17) describes combinations with 4 and more pesticidally active components. Thus, the support for the newly limited combinations is absent in the as-filed specification.

This is a matter of written description, not a question of what one of skill in the art would or would not have known. The material within the four corners of the as-filed specification must lead to the generic concept. If it does not, the material is new matter. Declarations and new references cannot demonstrate the possession of a concept after the fact.

Thus, the insertion of limitation “pesticidally active ingredient consisting of rosemary oil and phenethyl propionate” in claim 4 and the insertion of limitation “pesticidally active ingredient consisting of rosemary oil, peppermint oil and phenethyl propionate” in claim 19 are considered to be the insertions of new matter for the above reasons.

Art Unit: 1651

The claim 45 composition appears to find support in the composition EN5 of study A (page 9-10).

Applicants are hereby notified that the insertion of new matter into the claims has necessitated the removal of the claim rejection under 35 U.S.C. 102(b) as being anticipated by US 4,759,930 in the light of evidence by Fehr et al and/or in the light of evidence by Elamrani et al., because US 4,759,930 (Granirer et al.) discloses incorporation of boric acid (known insecticide for extermination of cockroaches) and the use plant leaves (not oils) including leaves of rosemary and peppermint in the method for killing insects.

However, removal of new matter will result in the reinstatement of the art rejection(s).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 45 as amended is rejected under 35 U.S.C. 102(b) as being anticipated by JP 07145598.

Claim is directed to a method for controlling household pests comprising step of applying to a location where control is desired a pesticidally-effective amount of a contact pesticidal composition comprising 1) a pesticidally active ingredient consisting of rosemary oil and

Art Unit: 1651

peppermint oil and 2) a carrier; wherein controlling comprises knocking down and killing the household pests.

JP 07145598 discloses a method for controlling household pests comprising step of applying to a desired pest control location a contact pesticidal composition comprising 1) a pesticidally active ingredient consisting of rosemary oil and peppermint oil and 2) a carrier in a form of additional plant oils (see English abstract; see official translation page 3/25 at section “purpose” and paragraphs 0020 and 0022). The method of the cited patent comprises active step of applying by placing composition in a pocket or in a chamber (translation par. 0016). The cited patent teaches a disinfection effect of the composition (English abstract, for example) and, thus, the cited patent is considered to teach controlling pests because the disinfection effect is reasonably expected to provide for sterilization/extermination and, thus, for killing generic household pests within the meaning of the claims. The household pests of the cited patent include mold and mites. The generic household pests of the instant application include mites as disclosed (page 4, line 28) and pests of foliage (page 4, line 25) that would include mold. Therefore, the cited patent is considered to anticipate the presently claimed invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 1651

Claims 4, 19 and 45 as amended are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 07145598 taken with US 4,759,930 (Granirer et al.) and US 3,761,584 (McGovern et al.).

Claims are directed to a method for controlling household pests comprising step of applying to a location where control is desired a pesticidally-effective amount of a contact pesticidal composition comprising rosemary oil in combination with one or more pesticidal compounds selected from the group consisting of peppermint oil and phenethyl propionate and a pesticidally acceptable carrier wherein controlling comprises knocking down and killing the household pests.

JP 07145598 is relied upon as explained above for the disclosure of a method for controlling household pests including molds and mites wherein the method comprises step of applying to a location where control is desired a pesticidally-effective amount of a contact pesticidal composition comprising rosemary oil, peppermint oil and other plant oils.

The cited JP 07145598 is lacking disclosure related to the use of phenethyl propionate in the compositions in the method for controlling or killing the household pests.

However, US 3,761,584 teaches that addition of phenethyl propionate provides for attracting pests or insects to the location where pest or insect control is desired (abstract).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the claimed invention was made to add phenethyl propionate to the pesticidal compositions comprising rosemary oil and peppermint oil in the method for controlling household pests of the cited JP 07145598 with a reasonable expectation of success in maximizing control over household pests. One of skill in the art would have been motivated to add phenethyl propionate

Art Unit: 1651

to pesticidal composition in order to attract the household pests to the location where pests are knocked down and killed for the expected benefits in maximizing pest extermination. It is well known that it is prima facie obvious to combine two or more ingredients each of which is taught by the prior art to be useful for the same purpose in order to form a third composition which is useful for the same purpose. The idea for combining them flows logically from their having been used individually in the prior art. In re Pinten, 459 F.2d 1053, 173 USPQ 801 (CCPA 1972); In re Susi, 58 CCPA 1074, 1079-80; 440 F.2d 442, 445; 169 USPQ 423, 426 (1971); In re Crockett, 47 CCPA 1018, 1020-21; 279 F.2d 274, 276-277; 126 USPQ 186, 188 (1960). Thus, the claimed invention as a whole was clearly prima facie obvious, especially in the absence of evidence to the contrary.

The claimed subject matter fails to patentably distinguish over the state art as represented by the cited references. Therefore, the claims are properly rejected under 35 USC § 103.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Art Unit: 1651

Claim 19 as amended is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-26 of U.S. Patent No. 6,531,163 in view of US 4,759,930 as explained in the prior office action.

The claims in the present application and the patent US 6,531,163 are each drawn to a method for controlling household pests including cockroaches by applying to the locus where control is desired a pesticidally effective amount of a composition with peppermint oil and phenethyl propionate. The claims of US 6,531,163 are broader and the patented method is open to the use of additional materials including additional pesticidal materials. The claimed method of the present application is different from the patented claims in that it requires a rosemary oil for controlling pests. However, it is recognized in the art that the pest controlling effects including pest-killing effects are produced by applying the peppermint oil-containing composition together with the rosemary oil-containing composition as adequately demonstrated by US 4,759,930 (see examples 12, 13 and 15-21).

Accordingly, the claimed methods in the present application and the patent US 6,531,163 are obvious variants. Thus, the inventions as claimed are co-extensive.

Response to Arguments

Applicant's arguments filed 7/05/2005 with regard to claim rejection over prior art have been considered but are moot in view of the new ground(s) of rejection.

With regard to the double patenting claim rejection applicants argue that claims of US 6,531,163 are devoid of any use of rosemary oil. Yet, the claimed invention is open to incorporation of additional ingredients to the mixture of peppermint oil with phenethyl

Art Unit: 1651

propionate and the cited patent clearly encompasses the use of additional essential oil. Rosemary derived essential oil is effective in method for combating household plant as adequately taught by the secondary reference. Thus, this claim rejection is proper.

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vera Afremova whose telephone number is (571) 272-0914. The examiner can normally be reached from Monday to Friday from 9.30 am to 6.00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Wityshyn can be reached at (571) 272-0926.

The fax phone number for the TC 1600 where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.

Vera Afremova

AU 1651

August 16, 2005



VERA AFREMOVA

PATENT EXAMINER